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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,177	01/29/2001	Ake Lindahl	003300-696	2132

35437 7590 10/17/2006

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NEW YORK, NY 10017

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,177

Applicant(s)

LINDAHL ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58,60-70,73,75-77,81-84,86-93,95 and 98-143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 58, 60-70, 73, 75-77, 81-84, 86-93, 95 and 98-143 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of response to election/restriction requirement filed 7/06/06. New claims 122-143 are added. Claims 58, 60-70, 73, 75-77, 81-84, 86-93, 95 and 98-121 and new claims 122-143 are pending.

Applicant elected polymerization reaction, antifungal agents and acid and alcohol as the one or more carrier starting material without specifically identifying the claims that read on the elected species.

Applicant traverses the requirement on the basis that the process by which the biologically active compositions are formed is the same for all the processes recited in the generic claims 107, 87, 108, 109, 110, 114, 122 and 143. Since applicant has admitted on the record that the processes recited in the independent claims are the same, a prior art that is used to reject claim 107 can also be used to reject claims 107, 87, 108, 109, 110, 114, 122 and 143. While the steps may not be quite the same from claim 107 to claims 107, 87, 108, 109, 110, 114, 122 and 143, examiner will consider this assertion when the election process is complete.

Applicant further states that there is no burden on the examiner to search all the chemical reactions/processes, namely, etherification, esterification, hydrolysis, substitution, elimination, oligomerization and polymerization that lead to the formation of the biologically active composition. These processes are different and examiner thanks applicant for electing polymerization reaction process.

Applicant appears to further state that the breaking and forming of covalent bond are one and the same process and that when cleavage of a covalent bond occurs a corresponding formation of a covalent bond would occur and such there is no difference in the technical feature

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and restriction or election should not be made. While it is true that the formation of chemical bond may involve breaking and making of a bond, the requirement was not particularly stating that the two cannot occur in the same reaction scheme. However, if A-B is a covalent compound, then the process of forming the A-B involves the formation of covalent bond in that compound and not in the breakage of the covalent bond in that compound A-B.

Furthermore, applicant states that "one or more carrier starting substances" does not constitute multiple species and would not place a burden on the examiner to search one or more starting carrier substances. However, on the contrary, this is not the case.

For example, in claim 64 the one or more carrier starting substances is selected from the group consisting of monomers, acids, alcohols, ketones, aldehydes, amines, amides, anhydrides, lactides, glycolides, saccharides, acrylic or acrylamide compounds, monomers of polyethylene oxide (PEO) diacrylate, cyanoacrylate, acrylate saccharides, acrylate lactate, acrylate glycolate, isocyanates, ethylene oxide, propylene oxide, pyrrolidone, PEO-diacrylate, ethylene-vinylacetate, monomers of organic siloxanes, and oligomers, polymers and prepolymers thereof.

In this claim the carrier can be any one or more than one of the materials listed therein. Examiner may find a composition that has an acid say, but would be required to search for a composition that contains acid and alcohol as claimed in claim 65. Claim 75 then requires the examiner to search for composition containing acrylic compound. Claim 83 further requires examiner to search for composition that comprises acrylate saccharide. It is appreciated that acrylate saccharide, acrylic compound, alcohol and acid are recited in claim 64 from which one compound may be identified in the search. Thus, yes, there is tremendous burden on the examiner to search for all the possibilities presented by claim 64.

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Therefore, while applicant may admit on the record that the reaction processes are the same in all the independent claims, applicant is required to elect a single biological composition that is fully defined by:

a) one carrier starting substance that is fully disclosed and if applicant intend to use a combination of carrier starting substance, the specific combination that is fully disclosed should be elected, that is one disclosed carrier starting substance or one combined carrier starting substance that is fully disclosed should be elected,

b) one fully disclosed reaction process (polymerization was elected in the response filed 7/06/06) should be elected, and

c) one fully disclosed pharmaceutically active agent should be elected.

In the previous election, applicant did not identify the claims that read on the elected species.

Applicant is thus respectfully requested that the reply must **also identify the claims readable on the elected species, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:
Species are different as described above.

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The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Hydrolysis is not the same reaction as polymerization or etherification or substitution or addition reaction. A single carrier starting substance differs in scope from a mixture comprising two or more carrier substances.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

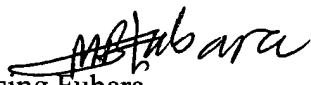
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Blessing Fubara
Patent Examiner
Tech. Center 1600